

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit : 1652  
Examiner : R. Hutson  
Serial No. : 08/808,031  
Filed : March 3, 1997  
Inventor : Sumiko Inouye  
: Mei-Yin Hsu  
: Masayori Inouye  
: Susan Eagle  
: Bert C. Lampson  
: Jung Sun  
: Jorge Vallejo-Ramirez  
Title : PROKARYOTIC REVERSE  
: TRANSCRIPTASE



22469

PATENT TRADEMARK OFFICE

Docket: 1491-CIP10-00  
(Formerly 377.5888P)

43/k  
A.G.J  
5/7/02

Dated: April 17, 2002

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AMENDMENT

Commissioner for Patents  
Washington, DC 20231

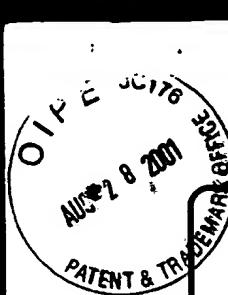
Sir:

In response to the Official Action dated November 16, 2001, Applicants amend the application as follows:

In the Specification (clean copy as amended)

Please replace the first paragraph on page 11 with the following:

Figure 14 shows the amino acid sequence alignment of bacterial RT carried out according to Xiong and Eickbush EMBO Journal, 9(10): 3353-3362, (1990). Amino acids highly conserved in eukaryotic Rts are shown at the top of the sequences. These amino acids include largely unvaried residues or chemically similar residues. (h) Hydorphobic residue; (p) small polar residues; (c) charged residue. Amino acids conserved in all seven bacterial



08-30-01

\$ CPA 1/652  
#37/50  
9/4/01

PTO/SB/29 (10-00)  
Applicable for use through 10/31/2002. OMB 0651-0032  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## CONTINUED PROSECUTION APPLICATION (CPA) REQUEST TRANSMITTAL

*Submit an original, and a duplicate for fee processing.*  
(Only for Continuation or Divisional applications under 37 CFR 1.53(d))

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AUG 31 2001  
CHECK BOX, if applicable.  
 DUPLICATE  
TECH CENTER 1600/2900

Address to:

Assistant Commissioner for Patents  
Box CPA  
Washington, DC 20231

Attorney Docket No. of Prior Application	377.5888P
First Named Inventor	Sumiko Inouye
Examiner Name	R. Hutson
Group Art Unit	1652
Express Mail Label No.	EL864965177US

This is a request for a  continuation or  divisional application under 37 CFR 1.53(d),  
(continued prosecution application (CPA) of prior application number 08 / 808,031,  
filed on 03/03/97, entitled PROKARYOTIC REVERSE TRANSCRIPTASE.

### NOTES

**FILING QUALIFICATIONS:** The prior application identified above must be a nonprovisional application that is either: (1) complete as defined by 37 CFR 1.51(b), or (2) the national stage of an international application in compliance with 35 U.S.C. 371. Effective May 29, 2000, a CPA may only be filed in a utility or a plant application if the prior nonprovisional application was filed before May 29, 2000. A CPA may be filed in a design application regardless of the filing date of the prior application. See "Request for Continued Examination Practice changes to and Provisional Application Practice," Final Rule, 65 Fed. Reg. 50092 (Aug. 16, 2000); Interim Rule, 65 Fed. Reg. 14865 (Mar. 20, 2000), 1233 Off. Gaz. Pat. Office (Apr. 11, 2000).

**C-I-P NOT PERMITTED:** A continuation-in-part application cannot be filed as a CPA under 37 CFR 1.53(d), but must be filed under 37 CFR 1.53(b).

**EXPRESS ABANDONMENT OF PRIOR APPLICATION:** The filing of this CPA is a request to expressly abandon the prior application as of the filing date of the request for a CPA. 37 CFR 1.53(b) must be used to file a continuation, divisional, or continuation-in-part of an application that is not to be abandoned.

**ACCESS TO PRIOR APPLICATION:** The filing of this CPA will be construed to include a waiver of confidentiality by the applicant under 35 U.S.C. 122 to the extent that any member of the public who is entitled under the provisions of 37 CFR 1.14 to access to, copies of, or information concerning, the prior application may be given similar access to, copies of, or similar information concerning, the other application or applications in the file jacket.

**35 U.S.C. 120 STATEMENT:** In a CPA, no reference to the prior application is needed in the first sentence of the specification and none should be submitted. If a sentence referencing the prior application is submitted, it will not be entered. A request for a CPA is the specific reference required by 35 U.S.C. 120 and to every application assigned the application number identified in such request, 37 CFR 1.78(a).

**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

1.  Enter the unentered amendment previously filed on June 29, 2001 under 37 CFR 1.116 in the prior nonprovisional application.
2.  A preliminary amendment is enclosed.
3. This application is filed by fewer than all the inventors named in the prior application, 37 CFR 1.53(d)(4).
  - a.  **DELETE** the following inventor(s) named in the prior nonprovisional application:  
08/31/2001 C GUYEN 00000035 08808031 .....
  - b.  The inventor(s) to be deleted are set forth on a separate sheet attached hereto.
4.  A new power of attorney or authorization of agent (PTO/SB/81) is enclosed.
5. Information Disclosure Statement (IDS) is enclosed:
  - a.  PTO-1449
  - b.  Copies of IDS Citations

[Page 1 of 2]

Burden Hour Statement: This form is estimated to take 0.4 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box CPA, Washington, DC 20231.

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CLAIMS	(1) FOR	(2) NUMBER FILED	(3) NUMBER EXTRA	(4) RATE	(5) CALCULATIONS
TOTAL CLAIMS (37 CFR 1.16(c) or (i))	17 -20* =	0	x \$ _____ =	\$	
INDEPENDENT CLAIMS (37 CFR 1.16(b) or (i))	4 -3** =	1	x \$ 80.00 =	80.00	
MULTIPLE DEPENDENT CLAIMS (if applicable) (37 CFR 1.16(d))			+ \$ _____ =		
			BASIC FEE (37 CFR 1.16)	710.00	
			Total of above Calculations =	790.00	
Reduction by 50% for filing by small entity (Note 37 CFR 1.27).				-395.00	
* Reissue claims in excess of 20 and over original patent. ** Reissue independent claims over original patent.			TOTAL =	395.00	

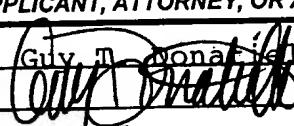
6.  Small entity status: Applicant claims small entity status. See 37 CFR 1.27.
7. The Commissioner is hereby authorized to credit overpayments or charge the following fees to Deposit Account No. 13 - 3405:
- Fees required under 37 CFR 1.16.
  - Fees required under 37 CFR 1.17.
  - Fees required under 37 CFR 1.18.
8.  A check in the amount of \$ 390.00 is enclosed.
9.  Payment by credit card. Form PTO-2038 is attached.
10.  Applicant requests suspension of action under 37 CFR 1.103(b) for a period of \_\_\_\_\_ months (not to exceed 3 months) and the fee under 37 CFR 1.17(i) is enclosed.
11.  New Attorney Docket Number, if desired 1491CIP1000  
*[Prior application Attorney Docket Number will carryover to this CPA unless a new Attorney Docket Number has been provided herein.]*
12. a.  Receipt For Facsimile Transmitted CPA (PTO/SB/29A)  
b.  Return Receipt Postcard (Should be specifically itemized, See MPEP 503)
13.  Other: .....

**NOTE:** *The prior application's correspondence address will carry over to this CPA  
UNLESS a new correspondence address is provided below.*

**14. NEW CORRESPONDENCE ADDRESS**

<input type="checkbox"/> Customer Number or Bar Code Label	022469	<input type="checkbox"/> or <input type="checkbox"/> New correspondence address below <i>(Insert Customer No. or Attach bar code label here)</i>
Name		
Address		
City	State	Zip Code
Country	Telephone	Fax

**15. SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED**

Name (Print / Type)	Guy T. Donahue, Jr.
Signature	
Registration No. (Attorney/Agent)	33,167
Date	



Attorney Docket No.: 1491-CIP10-00

In re Application of Sumiko Inouye et al

Serial No.: 08/808,031

Filed: March 3, 1997

For: PROKARYOTIC REVERSE TRANSCRIPTASE

COMMISSIONER FOR PATENTS  
Washington, DC 20231

Sir:

Transmitted herewith is an Amendment in the above-identified application.

- Small entity status of this application under 37 CFR §1.9 and §1.27 has been established by a verified statement previously submitted.
- A verified statement to establish small entity status under 37 CFR §1.9 and §1.27 is enclosed.
- No additional fee is required.

The fee has been calculated as shown below:

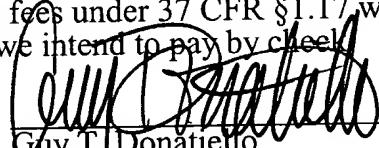
	(Col. 1)	(Col. 2)	(Col. 3)	SMALL ENTITY	OTHER THAN SMALL ENTITY
	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NO. PRE- VIOUSLY PAID FOR	PRESENT EXTRA		
TOTAL	* 12	-	** 20 =	0	
First presentation of multiple dependent claim					
			RATE	ADD'L FEE	
			x 9=	\$	
			x42=	\$	
			+140=	\$	
					OR
			RATE	ADD'L FEE	
			x18=	\$	
			x84=	\$	
			+280=	\$	

TOTAL ADDITIONAL FEE \$0 OR \$ \_\_\_\_\_

- \* If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.
- \*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, write "20" in this space.
- \*\*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (Total or Independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment or the number of claims originally filed.

- Please charge my Deposit Account No. 13-3405 in the amount of \$\_\_\_\_\_.  
A duplicate copy of this sheet is enclosed.
- A check in the amount of \$\_\_\_\_ is attached.
- The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 13-3405. A duplicate copy of this sheet is enclosed.
  - Any filing fees under 37 CFR §1.16 for the presentation of extra claims.
  - Any patent application processing fees under 37 CFR §1.17 with the exception of the Issue Fee which we intend to pay by check.

  
Guy T. Donatiello  
Reg. No. 33,167  
Attorney for Applicant(s)

GTD:MAP:gj  
(215)563-1810

O I P E J C 176  
AUG 28 2001  
P A T E N T & T R A D E M A R K O F F I C E

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Docket: 1491-CIP10-00  
(Formerly 377.5888P)

Dated: August 28, 2001

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**BOX CPA**  
Commissioner for Patents  
Washington, DC 20231

**EXPRESS MAIL CERTIFICATION**  
**37 C.F.R. §1.10**

Express Mail Label No.: EL864965177US

Date of Deposit: August 28, 2001

Description of Contents: Postcard, \$395.00 Check and Continued Prosecution Application (CPA) Request Transmittal, in duplicate.

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR §1.10 on the date indicated above and is addressed to **Box CPA**, Commissioner for Patents, Washington, DC 20231.

Debra Hill

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(*Typed or printed name of person mailing paper or fee*)

Debra Hill

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(*Signature of person mailing paper or fee*)